



Docket No.: 246481US90PCT

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COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/673,953

Applicants: Atsushi ITO, et al.

RCE Filed: JUNE 24, 2004

For: WAFER PROBER

Group Art Unit: 2829

Examiner: Paresh H. PATEL

SIR:

Attached hereto for filing are the following papers:

RESPONSE TO RESTRICTION REQUIREMENT
IDS/RELATED/LIST OF RELATED

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 246481US90PCT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

ATSUSHI ITO, ET AL. : EXAMINER: PARESH H. PATEL

SERIAL NO: 09/673,953 :

RCE FILED: JUNE 24, 2004 : GROUP ART UNIT: 2829

FOR: WAFER PROBER :

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated September 1, 2004, Applicant provisionally elects with traverse Group I, Claims 21-32 and 48-54, directed to a wafer prober for probing a semiconductor wafer. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional applications that cover the non-elected claims.

Applicant respectfully traverses the Restriction Requirement on the grounds that the wrong standard was applied. The present application is a national stage application filed under 35 U.S.C. § 371 so that the “Unity of Invention” standard should have been applied as opposed to the Restriction standard. In particular, the Restriction Requirement fails to provide evidence that there is no technical relationship among Group I and II that involves at least one common or corresponding special technical feature. As stated in MPEP 1893.03(d), “Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. § 371) applications.”

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Applicant respectfully traverses the Restriction Requirement on the grounds that the outstanding Restriction Requirement has not established that an undue burden would be required if the Restriction Requirement was not issued and if all the claims were examined together. More particularly, MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application no undue burden has been established if each of the claims were examined together. In contrast, the present restriction requirement subjects the Applicant to the added financial burden of prosecuting Claims 21-32, 48-54 (Group I) and Claims 33-47, 55-57 (Group II) in separate proceedings.

Applicants also note the Examiner has already examined all of the claims and replied to Applicants with the Office Actions of December 24, 2003 and March 13, 2003. Therefore, clearly there is no serious burden for the Examiner to examine Claims 21-57 together in one proceeding, as the Examiner has in fact already done so.

Additionally, Applicants respectfully request to include Claims 36 to 47 into Group I. In particular, as claimed, Claims 36 to 47 of Group II depend on independent Claim 21 of Group I.

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Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 21-57 be conducted.

Respectfully submitted,

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